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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,430	05/10/2001	Philip M. Ginsberg	CF/019	6761
1473	7590	07/19/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/853,430		GINSBERG ET AL.	
	Examiner		Art Unit	
	Olabode Akintola		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 4-13 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/30/02; 1/18/02; 5/3/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on May 10, 2001.

Claims 1-26 pending in the application are subject to restriction/election as discussed below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: Claims 1-3 and 14-16 are drawn to a method and system for displaying a bid or offer in an electronic trading system.

Invention II: Claims 4-13 and 17-26 are drawn to a method and system for processing a pending trade.

3. The inventions I and II are distinct, each from the other because of the following reasons:

Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable.

In the instant case, invention I relates to a method and system for displaying a bid or offer in an electronic trading system, whereas invention II relates to a method and system for processing a pending trade. The system of invention I can be performed by a system configuration different from what is claimed in invention II. Hence invention I has a different utility and scope than invention II. Because these inventions are distinct for the reasons given

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above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

After a phone call on June 19, 2006, a provisional election was made by Mr. Joel Weiss (Attorney for the Applicants) to prosecute claims 4-13 and 17-26. Accordingly claims 1-3 and 14-16 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 1-3 and 14-16 of invention II in response to this office action. Claims 4-13 and 17-26 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 5, 12, 13, 17, 18, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by (Silverman et al (U.S. Patent No. 5136501) (hereinafter referred to as Silverman).

Re Claims 4-8, 12, 13, 17-21, 25 and 26: Silverman teaches a system and corresponding method of processing a pending trade, the method comprising: determining whether execution of the pending trade would exceed a warning limit of a first trader in the pending trade; and executing the pending trade if execution of the pending trade would not exceed the warning limit of the

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first trader and would not exceed the warning limit of a second trader in the pending trade (col. 3, lines 18-38).

Re Claims 6, 7, 19 and 20: Silverman teaches the step comprising determining whether both the first trader and the second trader have selected to automatically execute only a portion of the pending trade; splitting the pending trade into an executable portion and an unexecutable portion; and executing the executable portion (col. 13, lines 16-24; Fig 18).

Re Claims 8 and 21: Silverman teaches the step comprising: determining whether both the first trader and the second trader have selected to automatically execute all of the pending trade; and executing the pending trade (col. 3, lines 18-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9, 10, 11, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Shepherd (U. S. Patent no. 5970479) (hereinafter referred to as Shepherd)

Re Claims 9, 10, 11, 22, 23 and 24: Silverman does not explicitly teach the step of determining whether at least one of the first trader and the second trader has selected to manually execute only a portion of the pending trade; prompting the at least one of the first trader and the second trader to determine whether the at least one of the first trader and the second trader wants to manually execute only a portion of the pending trade; splitting the pending trade into an executable portion and an unexecutable portion; and executing the executable portion. Shepherd teaches determining whether at least one of the first trader and the second trader has selected to manually execute only a portion of the pending trade; prompting the at least one of the first trader and the second trader to determine whether the at least one of the first trader and the second trader wants to manually execute only a portion of the pending trade; splitting the pending trade into an executable portion and an unexecutable portion; and executing the executable portion (col. 35, lines 24-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Shepherd. One would have been motivated to do this in order to give the parties and/or counterparties an alternative to automatic execution of all or a portion of the pending trade.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER